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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,611	12/31/2003	Luigi Fanti	P00830-US-01 (13030.0008)	8527
22446	7590	09/22/2005	EXAMINER	
ICE MILLER ONE AMERICAN SQUARE BOX 82001 INDIANAPOLIS, IN 46282			SCHATZ, CHRISTOPHER	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/749,611

Applicant(s)

FANTI, LUIGI

Examiner

Christopher T. Schatz

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 12-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-11 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) 1-22 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/5/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-11, drawn to a method, classified in class 156, subclass 299.
  - II. Claims 12-22, drawn to a product, classified in class 428, subclass 44.

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case that the product as claimed can be made by another and materially different process. As an example, the plastics floor tile could be molded and the joining film could then be joined to the floor tiles by an adhesive without the need for heat and pressure.

During a telephone conversation with Rachel St. Peter on August 16, 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

*Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3-7, 9, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 9 recite the limitation "said coupling agent." There is insufficient antecedent basis for this limitation in each claim.

*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Fanti '081.

Fanti discloses a method of manufacturing a plastics floor tile, the method comprising the steps of cutting a plurality of discrete plastics each said component

Art Unit: 1733

comprising a wear layer 14 having an upper surface and at least one backing layer 15 having a lower surface, from one or more sheets of a plastics material, assembling said components together to form at least a portion of a floor tile of the desired shape and design components (column 1, line 62 – column 2, line 25), securing said components together relative to one another by the application of at least one portion of a joining film 17 to said lower surface of the assembled said components so that said joining film spans at least the neighboring edges of adjacent said components (figure 2, column 2, lines 52-62).

As to claim 11, Fanti discloses method further comprising the step of chamfering abutting edges 20 of an upper surface of a wear layer (column 1, lines 47-54).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-7, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fanti as applied to claim 1 above, and in further view of Boba et al. '626.

Fanti discloses a method as stated in claim 1, but the reference is silent as to using a polymeric coupling agent. Boba et al. discloses a method for forming a flooring material, said method comprising bonding a polyvinyl chloride layer (column 3, lines 40-50) to a coating of a polymeric coupling agent, wherein said coupling agent is polyurethane (column 2, lines 54-68), and wherein during the bonding process the

Art Unit: 1733

material is subjected to heat and pressure such that said polyurethane coating reacts and cross-links with the PVC layer (column 6, lines 52-68). After said reaction occurs, a strong bond that is resistant to delamination is formed between said layer and said coating (column 2, line 54 – column 3, line 7, also see column 8, lines 64-68). It should be noted that the primary reference discloses that the backing layers 15, 16, and the joining film comprise PVC material (column 2, lines 52-62). As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to place a polymeric coupling agent comprising polyurethane between the joining film 17 and the backing layer 16 such that a strong bond resistant to delamination is formed.

As to claims 3 and 4, Boba et al. discloses a method wherein the temperature used is about 150 degrees F (column 5, lines 439-43). As to applicant's claimed pressure and time, examiner acknowledges that Boba et al. does not explicitly recite applicant's claimed time and pressure. However, it should be noted that the materials disclosed by Boba et al. – PVC and polyurethane – are the same materials applicant uses for the joining film, backing layer, and coupling agent, respectively. As such, it would be inherent that the coupling agent disclosed by Boba et al. would react with the PVC under the same conditions. Finally, examiner asserts that although Boba et al. is silent as to a method wherein the coupling agent bonds two layers of PVC together, the advantage of using polyurethane as the coupling agent would extend to a method wherein two layers of PVC are bonded together.

As to claims 5 and 6, the references do not explicitly recite a method wherein an upper of a portion of the assembled components is cooled by cold water to ambient temperature. However, it is well known in the art and advantageous to keep the top wear

Art Unit: 1733

layer at a low temperature as exemplified by Fanti (column 3, lines 48-63) such that no thermal damage occurs. As such, one of ordinary skill in the art would have recognized that, in a method wherein the entire surface of the top part of the press contacts the upper surface of the wear layer, it would be necessary to cool the upper part of the press with cold water to prevent thermal damage of said layer. Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to cool the wear layer to ambient temperature such that said layer is not thermally damaged. As to claim 7, one of ordinary skill in the art would have recognized to modify the method of Fanti such that a rubber press is used to insulate and further protect the wear layer from being subjected to heat that can cause thermal damage.

#### *Allowable Subject Matter*

8. Claim 8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. The prior art does not disclose a method wherein the joining film is provided with perforations. Additionally, no combination of the references would render the limitation obvious.

#### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher T. Schatz whose telephone number is 571-


Art Unit: 1733

272-1456. The examiner can normally be reached on 10:00-7:30, Monday -Thursday,  
10:00-6:30 Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on 571-272-1171. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CTS

  
TOM DUNN  
PATENT EXAMINER  
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